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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,614	08/13/2001	Heng Zhong	S-31514A	7523

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EXAMINER

KALLIS, RUSSELL

ART UNIT	PAPER NUMBER
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1638

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DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/928,614	Applicant(s) ZHONG ET AL.	
	Examiner Russell Kallis	Art Unit 1638	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, 14, 18-24, and 28-29, drawn to a method of producing a transformed sugar beet plant transformed with a nucleic acid expressing a polypeptide having PPO activity, shoot culture, transformed plant cells, and transformed plants, classified in class 800, subclass 278 for example.
- II. Claims 1-13, 15, 18-24, 25, and 29, drawn to a method of producing a transformed squash plant transformed with a nucleic acid expressing a polypeptide having PMI activity, shoot culture, transformed plant cells, and transformed plants, classified in class 800, subclass 310 for example.
- III. Claims 1-13, 15, 18-24, 26, and 29, drawn to a method of producing a transformed melon plant transformed with a nucleic acid expressing a polypeptide having PMI activity, shoot culture, transformed plant cells, and transformed plants, classified in class 800, subclass 309 for example.
- IV. Claims 1-13, 15, 18-24, 27, and 29, drawn to a method of producing a transformed watermelon plant transformed with a nucleic acid expressing a polypeptide having PMI activity, shoot culture, transformed plant cells, and transformed plants, classified in class 800, subclass 308 for example.



- V. Claims 1-13, 16, 18-24, and 29, drawn to a method of producing a transformed dicotyledonous plant transformed with a nucleic acid encoding a polypeptide having xylA activity, shoot culture, transformed plant cells, and transformed plants, classified in class 800, subclass 284 for example.
- VI. Claims 1-13, 17, 18-24, and 29, drawn to a method of producing a transformed dicotyledonous plant transformed with a nucleic acid encoding a polypeptide having GUS activity, shoot culture, transformed plant cells, and transformed plants, classified in class 800, subclass 298 for example.
- VII. Claims 30-45, drawn to a method of plastid transformation, classified in class 800, subclass 293 for example.
- VIII. Claims 46-50, drawn to transformed plastid genomes and plastids and plants containing them, classified in class 435, subclass 419 for example.

Inventions I-VI and VII-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Groups I-VI are drawn to a method of producing different plants whose nuclear genomes are transformed with nucleic acids that express polypeptides having different activities, and which different plants would require different transformation and tissue culture protocols; and the inventions of Groups VII-VIII are drawn to a method of plastid transformation that requires different method steps and genetic constructs than the nuclear transformation method for Groups I-VI.

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Inventions VII and VIII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product of VIII can be made by a materially different method, such as transforming protoplasts or embryonic callus with constructs containing regions of plastid homology.

Claims 1-13, 18-24, and 29 are common to Groups I-VI and will be examined to the extent they read upon the claimed invention. Claim 15 is common to Groups II-IV and will be examined to the extent that it reads on the elected invention.

Because the inventions are distinct for the reasons given above and have required a separate status in the art as shown by their different classifications, recognized divergent subject matter, and because the search required for one of the groups is not required for another restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (703) 305-5417. The examiner can normally be reached on Monday-Friday from 8:30-5:00 PM.

If attempts to reach Examiner by telephone are unsuccessful, the Examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone number for this Group is (703) 308-4242 or (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application, or if the examiner cannot be reached as indicated above, should be directed to the legal analyst, Gwendolyn Payne, whose telephone number is (703) 305-2475.

Russell Kallis, Ph.D.
November 14, 2002

DAVID T. FOX
PRIMARY EXAMINER
GROUP ~~160~~ 1638

